

## REMARKS

This paper is responsive to an Office Action mailed March 25, 2008. Prior to this response, claims 1-42 were pending. After amending claims 1, 9, 20, and 32, and canceling claims 2 and 21, claims 1, 3-20, and 22-42 remain pending.

In Section 3 of the Office Action, claims 1-6, 9-13, 16-23, 26, 29, 32-33, 36-38, and 41-42 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to DeHority (US 5,129,639) in view of Wadley (US 2002/0181014). The Office Action acknowledges that DeHority fails to disclose the determination of imaging job file type, but that Wadley's context-analyzer discloses this feature, and it would have been obvious to include the features of Wadley with DeHority's process as a way for an organization to monitor the content of documents being printed on organization printer resources. This rejection is traversed as follows.

DeHority discloses a process that uses paper supplies from a multi-paper supply system, where each supply corresponds to paper size, weight, color, and type. DeHority's process also uses stapling, folding, stacking, and duplexing options (col. 2, ln. 44-64). Each document to be processed includes a header where the paper, folding, stacking, stapling, and duplexing instructions are embedded. The process employs a best match strategy if the printer is unable to exactly comply with the header instructions (col. 3, ln. 5-50).

DeHority does not analyze the print job to determine file type. DeHority does not determine the print job characteristics in

response to determining file type. Rather, in DeHority's system the print characteristics are supplied in the header of the print job.

Wadley discloses a system where monitoring software installed on a printer is used to determine whether the data streams associated with documents are of interest to the organization [0009]. As an example, ink and the print media can be determined. The **Response to Arguments** Section of the Office Action states that Wadley teaches an imaging device that determines imaging job file type [0034], where the context-analyzer determines the type of document [0041].

In traverse, the Applicant notes that Wadley does not determine a file type, but rather a document context. More explicitly, Wadley discloses determining the content of a text document. In [0034] Wadley states that the context-analyzer is configured to analyze the data stream. "The analysis that is performed on the data stream by the context-analyzer pertains to, as the name implies, the context of the data stream itself. That is, each data stream that is printed necessarily has some context associated with it." Wadley's examples of context include an employment report, financial report, personnel evaluation, and resume.

Wadley discloses two means of analyzing context in the explanation of Fig. 6. They are: a structure detector and a keyword detector. The structure detector ascertains structures or fields in a document, while the keyword detector searches for words or phrases [0038-0040]. In [0041], Wadley states that by identifying documents that meet certain definable profile characteristics, the context-analyzer can make intelligent decisions as to the nature or type of documents that are being printed.

The Applicant respectfully submits that Wadley defines “document type” as the content or fields in a document. To further clarify the distinctions between Wadley and the claimed invention, claims 1 and 20 have been amended to recite that an imaging job file type is determined as either an electronic image file or an electronic text file, without the analysis of the imaging job content. Therefore, the limitation of “determining the imaging job file type” means that a determination is made as to whether an imaging job is an image file or a text file. Even if Wadley can be said to determine a *document* type (based upon context/content), Wadley does not disclose the determination of *file* type. More explicitly, Wadley does not disclose a context-analyzer that determines if a job is an image file or a text file.

Neither DeHority nor Wadley disclose the limitation of determining the imaging job characteristics. The Office Action states that DeHority discloses this limitation in col. 12, ln. 30-43. The cited section from DeHority states that printer capabilities are automatically matched to the print job requirements. “The system takes the job requirements and selects from among the resources presently available within the printer those that best match the requirements.” The cited passage discloses the *matching* of job requirements to printer capabilities, but does not disclose determining imaging job characteristics. In fact, DeHority explicitly states that the invention uses a document specification or document header to define the job requirements, such as paper type, stapling, or collation (col. 3, ln. 5-50). DeHority matches printer capabilities to the predetermined list of requirements. Even if using the document specification/header is considered to read upon the limitation of

“determining imaging job characteristics”, DeHority does not teach an invention that determines imaging job characteristics in response to initially determining the imaging job file type.

The Office Action states that Wadley discloses determining imaging job characteristics in [0041]. However, as noted above, Wadley describes ascertaining a document type in response to analyzing keywords and structures (fields) in a document [0038-0040]. In [0041] Wadley states that document types can be described by profiles, and that the context-analyzer can be programmed to look for specific document profiles. Wadley states that by defining profile characteristics, that intelligent decisions can be made.

To further distinguish the claimed invention limitation of determining imaging job characteristics from Wadley’s process of identifying document types by using profiles, claims 1 and 20 have been amended to recite that imaging job characteristics are associated with optimal print media, ink chemistry, or image processing.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, the *KSR International Co. v Teleflex Inc.* decision (82 USPQ2d 1385, 1395-1397, 2007) suggests 7 exemplary rationales to support a conclusion of obviousness, which include:

A) Combining prior art elements according to known methods to yield predictable results;

B) Simple substitution of one known element for another to obtain predictable results;

C) Use of known technique to improve similar devices (methods, or products) in the same way;

D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

E) "Obvious to try" – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;

G) Some teaching, suggestion, or motivation in prior art would have lead one of ordinary skill to modify the prior art reference or the combine prior art references teachings to arrive at the claimed invention.

The Office Action states that modifications to DeHority would have been obvious to one of ordinary skill in the art in light of Wadley. This rejection appears to be most closely grounded in the G) rationale - Some teaching, suggestion, or motivation in prior art would have lead one of ordinary skill to modify the prior art reference or the combine prior art references teachings to arrive at the claimed invention.

With respect to this rationale, MPEP 2143 (G) states that the rejection must articulate the following criteria to resolve the *Graham* factual analysis:

(1) a finding that there was some teaching, suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings;

(2) a finding that there was a reasonable expectation of success; and

(3) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

With respect to the above-referenced first factual analysis criteria, the Wadley reference has been combined with DeHority based upon the assumption that DeHority discloses all the limitations recited in Applicant's claims 1 and 20. However, the Office Action acknowledges that DeHority does not disclose determining imaging job file type, and as explained in detail above, Wadley does not disclose this limitation either. Wadley discloses ascertaining a document type based upon an analysis of keywords and content structure. But Wadley does not teach initially determining if a received job is either an image file or a text file.

Second, neither reference discloses the limitation of determining imaging job characteristics associated with print media, ink chemistry, or image processing. As noted above, DeHority's system accepts a document with a header that includes various finishing options. In other words, imaging job characteristics are delivered along with the job. Wadley is silent on the subject of determining imaging job characteristics associated with print media, ink chemistry, or image processing.

Third, neither reference discloses determining imaging job characteristics in response to initially determining the file type. Neither reference determines if the imaging job is either an image file or a text file. Neither reference uses this file type information to make

determinations concerning print media, ink chemistry, or image processing.

Therefore, even if elements from Wadley are combined with DeHority, that combination does not explicitly disclose every limitation of claims 1 and 20. Claims 3-6, 9-13, and 16-19, dependent from claim 1, and claims 22-23, 26, 29, 32-33, 36-38, and 41-42, dependent from claim 20, enjoy the same advantages.

The Office Action states that it would have been obvious to combine an imaging device determining the imaging job characteristics, in response to determining the imaging job file type, as taught by Wadley, with DeHority as a way for an organization to monitor the content of documents being printed on organization printer resources. However, Wadley does not disclose the determination of imaging job characteristics or imaging job file types. Neither does Wadley disclose determining imaging job characteristics in response to determining file type. As noted in the preceding paragraph, even if Wadley is combined with DeHority, no evidence has been provided to show that the combination teaches or suggests all the limitations of Applicant's claims 1 and 20.

Neither does the motivation of monitoring resources suggest determining an imaging job's characteristics in response to determining the file type. A *prima facie* analysis of motivation is especially critical in the present circumstances since the rejection is predicated on limitations that are not explicitly disclosed in the prior art references. The claimed invention can only be obvious if an artisan makes substantial modifications to the DeHority reference. However, there is nothing in the Wadley reference that suggests such a modification.

More explicitly, the argument behind the obviousness rejection appears to be that a practitioner would have been motivated to combine DeHority, a system that performs a best match between predetermined job requirements and printer capabilities, with Wadley, a system that analyzes document content. Assuming that the motivation to combine is based upon desire to monitor document content, this analysis does not explain how a practitioner would modify DeHority to make the claimed invention obvious. No analysis has been provided to explain why a practitioner would derive the limitation of determining file type. Neither DeHority nor Wadley disclose this limitation, and no analysis has been provided to explain why the monitoring of document content would make the requirement of this limitation obvious. In other words, the analysis of document content could be added to DeHority without the necessity of determining file type.

More important, no analysis has been provided that would explain why a practitioner would need to determine imaging job characteristics to aid in monitoring document content. Finally, no analysis has been provided that would explain why a practitioner would need to determine imaging job characteristics in response to initially determining file type. These limitations are not necessary in the task on content monitoring. Therefore, a practitioner would not be motivated to derive these limitations in an effort to add the analysis of document content to the DeHority reference.

Neither does the obviousness rejection provide evidence that such a modification would have been obvious to one with skill in the art based upon what was well known at the time of the invention. "(A)nalysis



[of whether the subject matter of a claim would have been obvious] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007). However, if the *prima facie* rejection is supported by what was known by a person of ordinary skill in the art then additional evidence should have been provided. Notable, when the source or motivation is not from the prior art references, “the evidence” of motive will likely consist of an explanation or a well-known principle or problem-solving strategy to be applied”. *DyStar*, 464 F.3d at 1366, 80 USPQ2d at 1649. The Office Action does not supply evidence that it was well known at the time of the invention to determine imaging job characteristics after first determining the imaging job file type.

With respect to the second analysis criteria needed to support the G) obviousness rationale, even if an expert were given the Wadley and DeHority references as a foundation, no evidence has been provided to show that there is a reasonable expectation of success in the claimed invention. That is, there can be no reasonable expectation of success if the references, and what was known by artisan at the time of the invention, do not teach all the limitations of the claimed invention.

In summary, the Applicant respectfully submits that a *prima facie* case of obvious has not been supported since the combination of Wadley and DeHority does not explicitly disclose every limitation of claims 1 and 20. Neither has a case been supported that DeHority can be

modified to supply the missing limitations in view Wadley or of what was well known by a person of skill at the time of the invention. Therefore, the Applicant requests that the rejection of claims 3-6, 9-13, 16-20, 22-23, 26, 29, 32-33, 36-38, and 41-42 be removed.

In Section 4 of the Office Action, claims 7 and 30 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to DeHority and Wadley, and further in view of Wiechers (US 2002/0075509). The Office Action acknowledges that DeHority and Wadley fail to disclose image resolution capabilities, but that Wiechers discloses this feature, and that it would have been obvious to include the features of Wiechers with the processes of DeHority and Wadley to determine time and cost parameters. This rejection is traversed as follows.

Even if Wiechers' imaging resolution capabilities are combined with Wadley and DeHority, the combination still fails to explicitly describe a process that determines imaging job characteristics in response to first determining the imaging job file type. Further, the satisfying of time and cost parameters does not suggest modifications to DeHority that would make these claim limitations obvious, based on either the Wadley/Wiechers references, or what was well known at the time. Since the combination of references neither explicitly discloses all the claim limitations, nor suggests modification to DeHority that would make all the limitations obvious, the Applicant requests that the rejection of claims 7 and 30 be withdrawn.

In Section 5 of the Office Action, claims 8 and 25 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to DeHority

and Wadley, and further in view of Neuhard (US 6,052,198). The Office Action acknowledges that DeHority and Wadley fail to disclose determining available print media information. The Office Action states that Neuhard discloses these features, and it would have been obvious to include the features of Neuhard with DeHority and Wadley to make a more efficient system. This rejection is traversed as follows.

Even if Neuhard's accessing of print media information is combined with Wadley and DeHority, the combination still fails to explicitly describe a process that determines imaging job characteristics in response to first determining the imaging job file type. Further, the improving of efficiency does not suggest modifications to DeHority that would make these claim limitations obvious, based on either the Wadley/Neuhard references, or what was well known at the time. Since the combination of references neither explicitly discloses all the claim limitations, nor suggests modification to DeHority that would make all the limitations obvious, the Applicant requests that the rejection of claims 8 and 25 be withdrawn.

In Section 6 of the Office Action, claims 14-15 and 39-40 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to DeHority in view of Wiechers. The Office Action acknowledges that DeHority fails to disclose matching system capabilities to job characteristics, but that Wiechers discloses this feature, and that it would have been obvious to include the features of Wiechers with DeHority to satisfy user time and cost parameters. This rejection is traversed as follows.

Even if Wiechers' system of matching network printer capabilities to job characteristics is combined with DeHority, the combination still fails to explicitly describe a process that determines imaging job characteristics in response to first determining the imaging job file type. Further, the satisfying of time and cost parameters does not suggest modifications to DeHority that would make these claim limitations obvious, based on either the Wiechers reference, or what was well known at the time. Since the combination of references neither explicitly discloses all the claim limitations, nor suggests modification to DeHority that would make all the limitations obvious, the Applicant requests that the rejection of claims 14-15 and 39-40 be withdrawn.

In Section 7 of the Office Action, claim 24 has been rejected under 35 U.S.C. 103(a) as unpatentable with respect to DeHority in view of Walker et al. ("Walker"; US 6,561,643). The Office Action acknowledges that DeHority fails to disclose a reader interface, but that Walker discloses this feature, and it would have been obvious to include the features of Walker with DeHority to automatically adjust printing for optimal images based upon sensing the media entering the printer. This rejection is traversed as follows.

If Walker's reader interface is combined with DeHority, the combination still fails to explicitly describe a process that determines imaging job characteristics in response to first determining the imaging job file type. Further, automatically making adjustments in response to the sensed media does not suggest modifications to DeHority that would make these claim limitations obvious, based on either the Walker reference, or what was well known at the time. Since the combination of

references neither explicitly discloses all the claim limitations, nor suggests modification to DeHority that would make all the limitations obvious, the Applicant requests that the rejection of claim 24 be withdrawn.

In Section 8 of the Office Action, claims 27 and 34 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to DeHority and Wadley, in view of Ferlitsch (US 6,943,905). The Office Action acknowledges that DeHority and Wadley fail to disclose a client with a print driver, but that Ferlitsch discloses this feature, and it would have been obvious to include the features of Ferlitsch with DeHority and Wadley to access information concerning imaging device status. This rejection is traversed as follows.

If Ferlitsch's client driver is combined with DeHority and Wadley, the combination still fails to explicitly describe a process that determines imaging job characteristics in response to first determining the imaging job file type. Further, accessing imaging device status does not suggest modifications to DeHority that would make these claim limitations obvious, based on either the Wadley and Ferlitsch references, or what was well known at the time. Since the combination of references neither explicitly discloses all the claim limitations, nor suggests modification to DeHority that would make all the limitations obvious, the Applicant requests that the rejection of claims 27, 31, and 34 be withdrawn.

In Section 9 of the Office Action, claims 28 and 35 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to DeHority

and Wadley, in view of Hayward et al. ("Hayward"; US 7,031,004). The Office Action acknowledges that DeHority and Wadley fail to disclose a client with a web page interface, but that Hayward discloses this feature, and it would have been obvious to include the features of Hayward with DeHority and Wadley for sending available print media information. This rejection is traversed as follows.

If Hayward's web interface is combined with DeHority and Wadley, the combination still fails to explicitly describe a process that determines imaging job characteristics in response to first determining the imaging job file type. Further, the sending print media information does not suggest modifications to DeHority that would make these claim limitations obvious, based on either the Wadley and Hayward references, or what was well known at the time. Since the combination of references neither explicitly discloses all the claim limitations, nor suggests modification to DeHority that would make all the limitations obvious, the Applicant requests that the rejection of claims 28 and 35 be withdrawn.

It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

Date: 6/6/2008

Respectfully submitted,

  
Gerald Maliszewski  
Registration No. 38,054

Customer Number 55,286  
P.O. Box 270829  
San Diego, CA 92198-2829  
Telephone: (858) 451-9950  
Facsimile: (858) 451-9869  
gerry@ipatentit.net